

I. The Office Action

The cover page of the office action mailed December 28, 2005 indicates that claims 7-9 and 13-33 are subject to restriction. The body of the office action states that:

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I: corresponding to a stacked configuration as shown in figure 5 and disclosed on page 11, lines 26-29.

Species II: corresponding to a Light Emission Device as shown in figure 7A-7B.

Species III: corresponding to a memory device as shown in figure 8A-8B and disclosed on page 15, lines 16-18 and 25-28.

Species IV: corresponding to an inductor as recited in claim 15.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Species I: claim 13-14.

Species II: claims 8 and 16.

Species III: claims 9 and 17.

Species IV: claim 15.

The following claims are generic: claims 7 and 18-33.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Species I does not require the particular structure feature recited on Species II through IV, and vice versa.

II. Response with Provisional Election and Traverse

In response, the applicant **provisionally** elects Species 1, claims 7, 13, 14, 18-33 with traverse. The applicant traverses because the restriction requirement does not comply with authority binding upon the examiner for the reasons noted below.

III. The Examiner has not Met the Burden Required in PCT Rules 13.1 and 13.2 and MPEP 1850 to Show Lack of Unity of Invention

PCT Rule 13.1 states that:

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 states that:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

MPEP 1850 outlines the examiner's standard for proving lack of unity of invention, stating in pertinent part, with emphasis supplied, that:

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. **There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant.** If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. **For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant.**

The applicant submits that the examiner has not presented the required "broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant." The examiner's argument is not supported by either (1) the international search, or (2) any additional document considered to be relevant, as specified in MPEP 1850.

Moreover, the MPEP states that in proving lack of unity of invention, the benefit of the